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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,915	07/13/2006	Christopher Becker	100792-1P US	1090

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ASTRA ZENECA PHARMACEUTICALS LP
GLOBAL INTELLECTUAL PROPERTY
1800 CONCORD PIKE
WILMINGTON, DE 19850-5437

EXAMINER

JEAN-LOUIS, SAMIRA JM

ART UNIT	PAPER NUMBER
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1617

MAIL DATE	DELIVERY MODE
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11/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,915	Applicant(s) BECKER ET AL.	
	Examiner SAMIRA JEAN-LOUIS	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 10 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 and 11 is/are rejected.
- 7) ☒ Claim(s) 8-9 and 12-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/20/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is in response to the amendment submitted on 08/20/08. Claims 1-5 and 7-14 are currently pending in the application, with claim 6 having being cancelled and claims 1-5, 10, and 14 having being withdrawn. Accordingly, claims 7-9 and 11-13 are being examined on the merits herein.

Receipt of the aforementioned amended claims is acknowledged and has been entered. Additionally, receipt of an Information Disclosure Stated filed on August 20, 2008 has been entered and signed. The Examiner further acknowledges applicant's request to cancel claims 1-5, 10, and 14 by an Examiner's Amendment upon agreement of allowable claims.

Applicant's argument with respect to the rejection under 35 U.S.C. § 112, second paragraph has been fully considered. However, given that applicant has amended claims 8, such arguments are now moot. Consequently, the rejection of claim 8 under 35 U.S.C. § 112, second paragraph is thereby withdrawn.

For the foregoing reasons, the rejection of claims 8 under rejection under 35 U.S.C. § 112, second paragraph and the rejection of claims 7, 9, and 11-13 under 103

Art Unit: 1617

(a) are withdrawn. However, in view of applicant's amendment, the following 103 (a)

Final rejection is being made.

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 102

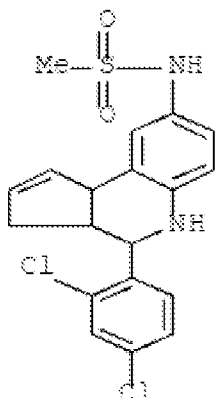
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7 and 11 are rejected under 35 U.S.C. 102 (e) as being unpatentable over Koutnikova et al. (WO 2004/072046 A2).

Koutnikova et al. teach compound that modulate nuclear receptor activity. In particular, Koutnikova et al. teach the compound N-[4-(2,4-Dichloro-phenyl)-3a,4,5,9b-tetrahydro-3H-cyclopenta[c]quinoline-8-yl-methanesulfonamide (also known as CRX 001018) with the following structure,



(see abstract and pg. 153, lines 25-27).

Particularly, the aforementioned compound, CRX 001018, of Koutnikova et al. reads on applicant's formula I, wherein R1 is NR²-SO₂-R₂ (i.e. NHSO₂C₁-alkyl or NHSO₂methyl) and Ar is a phenyl which is di-substituted with halogen (i.e. 2 R₃ substituents that are chlorine).

Accordingly, Koutnikova et al. anticipate claims 7 and 11.

Objections

1. Claims 8-9 and 12-13 are objected to because of the following informalities: Claims are dependent upon cancelled claims. Applicant is required to incorporate all of the limitations of claims 7 and 11 into claim 8-9 and 12-13. Appropriate correction is required.

Conclusion

No claims are allowed.

Art Unit: 1617

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samira Jean-Louis whose telephone number is 571-270-3503. The examiner can normally be reached on 7:30-6 PM EST M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. J. L. /

Examiner, Art Unit 1617

11/24/2008

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617